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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Eckhard H. KUESTERS

GROUP: 3713

SERIAL NO: 10/616,905

EXAMINER: PANOS, J. C.

RCE FILED: January 13, 2005

FOR: A GOLF BALL INCLUDING AN ELECTROMAGNETIC TRANSMITTER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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PRE-APPEAL BRIEF CONFERENCE ARGUMENTS

In the Final Office Action of April 19, 2006, claim 2 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; claims 1, 2, and 4-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Englmeier (U.S. Patent No. 5,423,549) in view of Barnhill (U.S. Patent No. 5,112,055) and further in view of Stoffer (U.S. Patent No. 5,463,376); and claim 3 was objected to as depending from a non-allowed claim.

I. Claim 2 is enabled

Applicant acknowledges with appreciation the personal interview between the Examiner, the Examiner's supervisor and Applicant's representatives on May 18, 2006. The scope of the interview was limited to the outstanding rejection under 35 U.S.C. § 112, first paragraph. During the interview, Applicant's representatives argued that current claim is supported by the specification, at least in the following locations: page 8, lines 4-17, page 10, lines 5-13, and page 13, lines 18-20. Applicant's representatives also noted that an exact duration of the timer in question was not a question of enablement, but was instead a question of marketing. That is, as evidenced by the art of record, one skilled in the art would know how to set a timer in a golf ball once the idea of placing a timer in a golf ball was conceived. A particular timer setting is clearly a matter of design choice based on the choice of a particular battery, anticipated number of cycles of transmission (e.g., the typical life of a golf ball is at most several rounds of 18 holes), and transmitted power per transmission cycle. The Examiners acknowledged at the interview that the currently claimed invention was enabled. The Examiners indicated that the outstanding rejection under 35 U.S.C § 112, first paragraph would be withdrawn upon receipt of formal comments. Withdrawal of this rejection is therefore respectfully requested.

II. The Applied Prior Art Does Not Teach or Suggest Claimed Invention

Applicant respectfully traverses the outstanding prior art rejection on the basis that there is no motivation in the applied prior art to have combined their teachings so as to arrive at the claimed invention.

Englmeier describes a golf ball with a transmitter unit 3, an energy store 4, an energy receiver 7, a control unit 13, and a constant current source 24. Englmeier discloses:

> [the] control unit . . . actuates the transmitter unit, with the energy store [4] having a capacity which is dimensioned for a temporally restricted operating period of the control unit and/or the transmitter unit.
>
> . . . [T]he transmitter operation is restricted timewise since the transmitter unit can only operate as long as the residual capacity of the energy store is sufficient to operate the control unit or the constant current source. In this manner it is possible to reliably prevent the transmitter unit being able to transmit disturbing signals over a longer period of time with reducing intensity in accordance with the residual capacity of the energy store.
>
> After the termination of the transmission operation of the transmitter unit of a golf ball, renewed operation is only then possible when the golf ball has been found and recharged. In this way it can be reliably ensured that the localization of another golf ball is not hindered in undesirable manner.[1]

Englmeier teaches that transmission is continuous as long as the energy store retains energy sufficient for further transmission, and transmission of signal is maintained even during recharging of the energy store. Thus, according to Englmeier, when the golfer finds his ball before the energy store is depleted, continuous transmission is maintained while recharging and remains uninterrupted and continuous for at least another recharging cycle. Therefore the Englmeier golf ball transmits pulsed signals continuously until the Englmeier energy store is depleted, or until the energy store is recharged and then depleted, *not for a predetermined time period*. Englmeier merely discloses a golf ball having a finite energy source and which transmits pulse signals so long as the energy source is not depleted.

Englmeier fails to teach either (1) "a shock actuated switching device contained within the body; and a timing device configured to control transmission of the

[1] Englmeier, column 2, lines 12-33.

electromagnetic signal for a predetermined time period after [shock] actuation of the switching device" as recited in independent claim 1; or (2) "means coupled to the power source for transmitting an electromagnetic signal for a predetermined time period in response to application of a shock to the golf ball" as recited in independent claim 12.

Barnhill discloses a golf ball with a "Novel Sound-Emitter Device."[2] This device, "shock-activated in nature, is provided to be silent through the practice swing, but automatically emits a sound upon the ball being struck, and it keeps sounding until the player finds it and wishes it silent for the next shot . . .."[3] Barnhill teaches that "[s]ilencing . . . requires merely the minor task . . . of pushing an available rod [e.g., a golf tee] . . . through the wall 24's hole 25, and interiorly of the device far enough that the outer body part . . . of the inner shell body 26 slides . . . past the latch 29; and that latching opens (disengages) the contact of the clip arm 39c and the screwbody 32's outer head 46."[4] Thus, the shock activated sounding device taught by Barnhill keeps sounding until the player finds it and wishes it silent for the next shot,[5] i.e., until the player manually shuts off the sound transmission.

First, Barnhill fails to teach shock activated electromagnetic signal transmission, but instead teaches shock activated sound transmission. Furthermore, Barnhill like Englmeier fails to teach or suggest provision of a timing device and instead teaches transmission for an indeterminate period of time after actuation, depending on the length of time it takes for the golfer to locate the golf ball and manually deactivate the transmitter. Barnhill thus reinforces the Englmeier teaching of transmitting for an indeterminate time period and neither reference teaches or suggests the provision of a timing device to control transmission of a signal for a predetermined, i.e., determined in advance, time period.

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[2] Barnhill, column 6, line 64 through column 10, line 68; and Figures 6 – 11.
[3] Id., Abstract.
[4] Barnhill, column 9, lines 21-30.
[5] Id., Abstract.

Stoffer discloses a system and method for synchronizing a receiver of an electronic article surveillance system and a transmitter thereof. The Stoffer electronic article system particularly relates to electronic article surveillance systems "of the type that detect a resonant marker or tag that is placed in a swept frequency electromagnetic field near the exit to a protected area. The system detects perturbations or tag signals that are generated when the frequency of the swept field passes through the resonant frequency of the tag to provide an alarm signal."[6]

Quite clearly, Stoffer has nothing to do with a golf ball. It is not clear why or how one skilled in the art would have been motivated by Stoffer to modify the golf ball suggested by the combined teachings of Englmeier and Barnhill so as to arrive at the claimed invention.

The outstanding Office Action finds Stoffer pertinent on the basis that "Stoffer discloses a timing device **capable of being configured** to control transmission of the signal for a predetermined time after actuation (column 5, lines 41-67)."[7] According to the Official Action, "in incorporating this energy saving mechanism [i.e., pulse transmission], Englmeier discloses a transmitter than **can be** turned ON and OFF by a timer circuit taught by Stoffer (column 5, lines 41-67) in order to limit the time during which the ball transmits."[8] These statements in the outstanding Office Action underscore the lack of real motivation to combine the prior art as taken in the outstanding Office Action. Merely because the golf ball of Englmeier **could be** redesigned to include a timer does not make such a modification obvious under 35 U.S.C. § 103.

There must be some motivation in the references themselves for combining these references to arrive at the claimed invention. Englmeier and Barnhill include no teaching of transmitting for only a predetermined time period, and instead each teaches transmitting until its power source is either depleted, recharged or turned off by the player. Englmeier does not

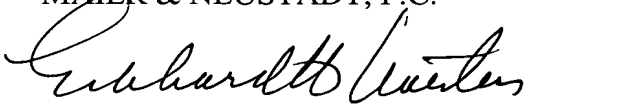
[6] Stoffer, Field of the Invention.
[7] Official Action dated April 19, 2006, page 4, last paragraph.
[8] Id., page 4, lines 8-10.

even teach an electromagnetic transmitter which can be turned off. While Stoffer teaches "an alarm timer 50 that will trigger an alarm for a predetermined time period,"[9] this teaching by Stoffer provides no motivation to apply a timer to the Englmeier golf ball transmitter which is in no need for triggering an alarm absent the use of impermissible hindsight. This highly limited teaching of the Stoffer patent certainly would not have taught a person skilled in the art to have provided the Englmeier golf ball with a timer to control electromagnetic transmission for a predetermined transmission period after actuation.

When the actual teachings of the applied prior art are considered without hindsight, it is clear that the two golf ball transmitter references, Englmeier and Barnhill, teach and suggest only indeterminate transmission times. In fact, if the golf ball of Englmeier were to be modified to be shock-activated as taught by Barnhill, the golf ball would then by necessity have to be deactivated manually as taught by Barnhill so as to be able to be shock-activated on the next shot. The Stoffer patent provides no motivation to remedy this deficiency of the teachings of Englmeier and Barnhill absent the use of impermissible hindsight. Accordingly, it is respectfully submitted that there is no motivation in the applied prior art to have combined their teachings so as to arrive at the claimed invention. Withdrawal of the outstanding grounds for rejection on the merits and allowance of Claims 1, 2, and 4-20 is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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[9] Stoffer, column 5, lines 62-64.